



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,103	11/29/2000	Eiji Ohara	1163-0305P	8743

7590 08/11/2004

BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,103

Applicant(s)

OHARA ET AL.

Examiner

Bob Chevalier

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-12 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1129/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Murayama et al.

Murayama et al discloses a video recording/reproducing apparatus that shows all the limitations recited in claim 1, including the feature of receiving transmitted digital data including a plurality of multiplexed programs consisting of video, audio, data and so forth which are subjected to compression (See Murayama et al's Figure 2), the feature of selecting a program to be recorded from among the plurality of multiplexed programs in response to an instruction from a user (See Murayama et al's Figure 2, components 27, 23, 36, 38, and 37, and further, see Murayama et al's column 4, lines 39-55, and column 7, lines 22-33), the feature of the recorder for storing digital data of the program selected by the program selector, and for reproducing recorded digital data (See Murayama et al's Figure 1, component 2), and the feature of decoding digital data reproduced by the recorder to restore the selected program as specified in the present claim 1. (See Murayama et al's Figure 2, component 28, and 29).

With regard to claim 2, the feature of the receiver and the decoder being included in the set-top box as specified thereof is present in Murayama et al (See Murayama et al's Figure 2, and Figure 1, component 1), and further, the feature of the program selector being included in the VTR as specified in the present claim 2 would have been inherently present in the cited reference of Murayama et al, since, conventional DVTR such as the one disclosed in the cited reference of Murayama et al would have necessarily included the capability to perform program selection for recording purposes on the recording medium provided thereof.

With regard to claim 3, the feature of the receiver, the decoder, the program selector being included in the set-top box as specified thereof would be present in Murayama et al. (See Murayama et al's Figure 2).

3. Claims 4-12 contain allowable subject matter over the prior art of record.
4. The following is a statement of reasons for the indication of allowable subject matter:

The claimed invention is directed a digital data recording/reproducing system. The independent claim identifies the feature of "detecting a discontinuity between the programs while the decoder is decoding the compressed digital data of the programs, wherein the discontinuity detector restarts said decoder upon detecting the discontinuity between the programs". The closest prior art, Murayama et al discloses a conventional video recording/reproducing apparatus, either singularly or in combination fails to anticipate or render the above underlined limitations obvious.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. Yanagihara et al discloses a video recording/reproducing apparatus for recording received data from a receiving apparatus.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 703-305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier

. Application/Control Number: 09/725,103
Art Unit: 2616

Page 5

August 7, 2004.


ROBERT CHEVALIER
PRIMARY EXAMINER